

REMARKS

Claims 1-15 are pending. Claims 1, 8 and 15 have been amended to be in better form. No new matter has been presented.

Claims 1, 7, 8, 14 and 15 stand rejected under 35 USC 102(b) as being anticipated by Hamilton, U.S. Patent No. 5,715,381. This rejection is respectfully traversed.

Claim 1 recites “a job holding section for storing the job in a storage section *when it is determined by the template determination section that the job contains the template*” (emphasis added). The Examiner asserts that Hamilton teaches a local memory in the controller that may store packages and their contents and that Hamilton also discloses that it is well known that jobs that are transferred and interpreted by a network printer, called decomposing jobs, stores the jobs for output, which the Examiner asserts reads on the claimed making the job stored in a storage section when it is determined by the template determination section that the job contains the template.

Applicant does not dispute the fact that Hamilton contains a memory or that Hamilton discloses that jobs transferred over the network will be stored, however Hamilton does not specifically teach that a job is stored in a storage section *when it is determined by the template determination section that the job contains the template*. Thus, Hamilton fails to teach or suggest all of the features of the claimed invention.

Claims 8 and 15 recite substantially similar features to claim 1, and are allowable for the same reasons. Claims 7 and 14 are allowable at least due to their respective dependencies. Applicant requests that this rejection be withdrawn.

Claims 2-4 and 9-11 stand rejected under 35 USC 103(a) as being unpatentable over Hamilton in view of Dimperio, U.S. Patent No. 6,965,445. Claims 5 and 12 stand rejected under 35 USC 103(a) as being unpatentable over Hamilton in view of “well know prior art.” Claims 6 and 13 stand rejected under 35 USC 103(a) as being unpatentable over Hamilton in view of Dimperio and further in view of Suzuki, U.S. Patent No. 5,878,196. These rejections are respectfully traversed.

With respect to claim 2, the Examiner admits that Hamilton does not teach that the template is contained in a job name, but asserts that this is well known in the art. However, notwithstanding how well known this might be, one of ordinary skill in the art must have been motivated to modify Hamilton to include the template in the job name. Since Hamilton uses a system which identifies various properties associated with a given package, including a property which has an inserted merge item, one would need to completely abandon the notion of properties associated with a package and label each job to indicate that there is a merge item therein. This completely changes the way Hamilton already achieves the same result and thus there would be no reason to modify Hamilton in this way except in an attempt to recreate the claimed invention in hindsight. The Examiner is not permitted to do this.

The same rationale applies to each of the rejections of the dependent claims in view of this combination of references. Hamilton's system achieves its objective in one fashion and absent a showing that modifying this way of doing things would achieve some benefit other than recreating the claimed invention, there simply would have been no motivation to modify Hamilton as suggested by the Examiner.

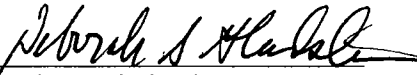
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and

authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 204552032100.

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Respectfully submitted,

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